

**REMARKS**

Entry of the above amendments is respectfully requested.

**Summary of Amendments**

Upon entry of the present Amendment claims 11-32 are cancelled and claims 33-54 are added, whereby claims 33-54 will be pending, claims 33, 39, 50 and 52 being independent claims. Support for the new claims can be found throughout the present specification. See, e.g., page 8 and the Examples.

Applicants emphasize that the cancellation of claims 11-32 is without prejudice or disclaimer, and Applicants expressly reserve the right to prosecute the cancelled claims in one or more divisional and/or continuation applications.

**Summary of Office Action**

As an initial matter, Applicants note with appreciation that the Examiner has indicated consideration of the Information Disclosure Statement filed December 13, 2010. In this regard, it is noted that on May 2, 2011 a further Information Disclosure Statement was filed and the Examiner is respectfully requested to indicate consideration of the May 2, 2011 Information Disclosure Statement in the next communication from the Patent and Trademark Office.

Applicants further note with appreciation that claims 28 and 29 are indicated to be allowable upon the filing of a terminal disclaimer and that most of the rejections set forth in the previous Office Action appear to have been withdrawn.

Claims 11, 17-24, 28 and 29 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over several claims of U.S. Patent No. 7,825,074.

Claims 11-27, 31 and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over several claims of co-pending Application No. 11/721,201.

Claims 12-16 and 19-22 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 14-16 are rejected under 35 U.S.C. § 112, fourth paragraph, as allegedly being of improper dependent form.

Claims 11-17, 19-27, 31 and 32 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Popall et al., U.S. Patent No. 5,734,000 (hereafter “POPALL”).

Claims 11-16, 23 and 24 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Zhang et al., U.S. Patent No. 5,858,280 (hereafter “ZHANG”).

Claims 11-16, 23 and 24 rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tanaka et al., U.S. Patent No. 4,308,371 (hereafter “TANAKA”).

Claim 27 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schmidt et al., U.S. Patent No. 6,287,639 (hereafter “SCHMIDT”).

Claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over TANAKA.

Claim 30 remains rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Espin et al., U.S. Patent No. 6,513,592 (hereafter “ESPIN”) in view of SCHMIDT.

### **Response to Office Action**

Reconsideration and withdrawal of the rejections set forth in the present Office Action are respectfully requested, in view of the foregoing amendments and the following remarks.

### ***Response to Obviousness-Type Double Patenting Rejections***

Claims 11, 17-24, 28 and 29 are rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over several claims of U.S. Patent No. 7,825,074 and claims 11-27, 31 and 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over several claims of co-pending Application No. 11/721,201.

Applicants respectfully request that these rejections be held in abeyance until allowable subject matter has been indicated. Applicants will then decide whether appropriate action to overcome these rejections needs to be taken.

### ***Response to Rejections under 35 U.S.C. § 112***

Claims 12-16 and 19-22 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention and claims 14-16 are rejected under 35 U.S.C. § 112, fourth paragraph, as allegedly being of improper dependent form.

Applicants respectfully disagree with the Examiner in this regard. At any rate, the rejected claims are cancelled, wherefore these rejections are moot.

***Response to Rejection under 35 U.S.C. § 102(b) over POPALL***

Claims 11-17, 19-27, 31 and 32 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by POPALL. The rejection essentially alleges that all of the elements recited in the rejected claims are disclosed by POPALL.

Applicants respectfully disagree with the Examiner in this regard and note that the rejected claims are cancelled, wherefore this rejection is moot.

Regarding the claims submitted herewith, it is not seen that POPALL teaches or suggests the subject matter of any of these claims. In this regard, it is noted that POPALL is directed to a silicon-based lacquer for coating substrates such as PET capacitors (see, e.g., abstract and Examples of POPALL). Accordingly, POPALL clearly fails to disclose or render it obvious to one of ordinary skill in the art to use the lacquer taught therein for the consolidation of geological formations or for the consolidation of porous and/or particular materials such as, e.g., sand and/or to make molded articles from these materials.

***Response to Rejection under 35 U.S.C. § 102(b) over ZHANG***

Claims 11-16, 23 and 24 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by ZHANG. The rejection essentially alleges that all of the elements recited in the rejected claims are disclosed by ZHANG.

Applicants respectfully disagree with the Examiner in this regard as well and note that the rejected claims are cancelled, wherefore this rejection is moot.

Regarding the claims submitted herewith, it is not seen that ZHANG teaches or suggests the subject matter of any of these claims. In this regard, it is noted that ZHANG is directed to a transparent methyl-modified silica gel, which gel can be made into self-sustained (protective) coating films or may serve as a host material for doping optically functional molecules. See, e.g., abstract and col. 2, lines 27-33 of ZHANG. Accordingly, ZHANG clearly fails to teach or render it obvious to one of ordinary skill in the art to use the transparent methyl-modified silica gel taught therein for the consolidation of geological formations or for the consolidation of porous and/or particular materials such as, e.g., sand and/or to make molded articles from these materials.

***Response to Rejections under 35 U.S.C. § 102(b) and § 103(a) over TANAKA***

Claims 11-16, 23 and 24 rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by TANAKA and claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over TANAKA. The rejection essentially alleges that all of the elements recited in claims 11-16, 23 and 24 are disclosed by TANAKA and that the additional elements of claims 17 and 18 are rendered obvious thereby.

Applicants respectfully disagree with the Examiner in this regard as well and note that the rejected claims are cancelled, wherefore these rejections are moot.

Regarding the claims submitted herewith, it is not seen that TANAKA teaches or suggests the subject matter of any of these claims. In this regard, it is noted that TANAKA is directed to a process for preparing a thermosetting organopolysiloxane which is soluble in an organic solvent and can be used for manufacturing a coated plastic material product made of a plastic material that is deformable at a relatively low temperature. See, e.g., abstract and col. 6,

lines 3-8 of TANAKA. Accordingly, TANAKA clearly fails to disclose or render it obvious to one of ordinary skill in the art to use the thermosetting organopolysiloxane which is soluble in an organic solvent taught therein for the consolidation of geological formations or for the consolidation of porous and/or particular materials such as, e.g., sand and/or to make molded articles from these materials.

***Response to Rejection under 35 U.S.C. § 102(b)/§ 103(a)***

Claim 27 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as allegedly being unpatentable over SCHMIDT. The rejection alleges that SCHMIDT teaches a consolidated molded article and that if there is any difference between the product of SCHMIDT and the product of claim 27 the difference would allegedly be minor and obvious.

Applicants respectfully disagree with the Examiner in this regard as well and note that claim 27 is cancelled, wherefore this rejection is moot as well.

***Response to Rejection Claim 30 under 35 U.S.C. § 103(a)***

Claim 30 remains rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ESPIN in view of SCHMIDT. The rejection again alleges that ESPIN teaches a process for consolidating sand formations comprising injecting a consolidation system into the formation and curing thereof and further teaches the consolidation system comprises nanoparticles as disclosed in PCT/EP97/06370, of which SCHMIDT is the English equivalent. The rejection further alleges that “[i]t would have been obvious to a person of ordinary skill in the art to inject

the consolidated article of [SCHMIDT] into the formation and curing thereof for the benefit of consolidating sand formations, because [ESPIN] expressly teaches the use of the composition of ... [SCHMIDT]”.

Applicants respectfully disagree with the Examiner in this regard for all of the reasons which are set forth in the Appeal Brief filed December 8, 2009, the Reply Brief filed March 23, 2010, the Submission under 37 C.F.R. § 1.114 filed July 19, 2010, and the response to the previous Office Action. The corresponding remarks are expressly incorporated herein. At any rate, claim 30 is cancelled, wherefore this rejection is moot.

It further is noted that claim 52 submitted herewith (based on claim 30) recites that cured consolidated articles are introduced into channels within the geological formation. It is not seen that ESPIN teaches or suggests a corresponding process. For example, according to ESPIN a liquid is injected into the formation, the liquid being cured only after the injection.

**CONCLUSION**

In view of the foregoing, it is believed that with the possible exception of obviousness-type double patenting issues, if any, all of the claims in this application are in condition for allowance. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to telephone the undersigned at the telephone number below.

Respectfully submitted,  
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/Heribert F. Muensterer/

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October 10, 2011  
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